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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/926,882	09/10/1997	SHIGEO YAMAGATA	B208-062-DIV	7670

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/926,882

Applicant(s)

YAMAGATA ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003 and 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 38-44 and 49-55 is/are pending in the application.
- 4a) Of the above claim(s) 38-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 08/271,230.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed Nov. 10, 2003 have been fully considered but they are not persuasive.

In re page 7, applicants state that the Examiner, in repeating the same reasons for the rejection, has failed to consider and address applicants' arguments presented in the Response After Final Under 37 CFR § 1.116, filed on September 9, 2003 and applicants hereby incorporate those arguments herein by reference and repeat below pertinent portions thereof.

In response, it is noted that the Examiner does not fail to consider and address applicants' arguments presented in the Response After Final filed on September 9, 2003 because the response filed on September 9, 2003 is similar to the previous response filed Jan. 27, 2003. Since both responses are similar, the reasons for the rejection of the Final Office Action mailed April 09, 2003 are repeated in the Advisory Action mailed Oct. 06, 2003.

In re pages 7-8, applicants argue that Shimada et al fails to teach or suggest a device in which first type data is superimposed in a first mode and first and second type data are superimposed in a second mode, and the position in which the first type data is superimposed in the first mode differs from the position in which the first type data is superimposed in the second mode.

In response, as discussed in the Final Office Action mailed April 09, 2003 and in Advisory Action mailed Oct. 06, 2003 that DATA1 is recorded in mode "01" and DATA1

and DATA2 are recorded in mode "11". The amount of DATA1 in mode "01 and DATA1 and DATA2 in mode "11" are different. the position at which the data of the first type (DATA1 in mode "01") is superimposed on a display screen in the first mode and the position at which the data of the first type (DATA1 and DATA2 in mode "11") is superimposed on a display screen in the second mode are different from each other because the amount of data (DATA1 in mode "01" and DATA1 and DATA2 in mode "11") in two modes (mode "01" and mode "11") are different.

It is noted that the claimed first type data is anticipated by DATA1 of Shimada et al, that the claimed second type data is anticipated by DATA2 of Shimada et al, that the claimed first mode is anticipated by mode "01" of Shimada et al, and that the claimed second mode is anticipated by mode "11" of Shimada et al.

It is further noted that, in first mode (mode "01" of Shimada et al), **only DATA1** of Shimada et al is superimposed on the reproduced video signal and, in second mode (mode "11" of Shimada et al), **both DATA1 and DATA2** of Shimada et al are superimposed on the reproduced video signal. The amounts of data (DATA1 in mode "01" and DATA1 and DATA2 in mode "11") in two modes (mode "01" and mode "11") are different. Since the amounts of data in two modes are different, the position on which the first type data (DATA1 in mode "01") is superimposed in the first mode (mode "01") differs from the position in which the first type data (DATA1 in mode "11") is superimposed in the second mode (mode "11"). Thus, Shimada et al does indeed disclose the claimed device in which first type data is superimposed in a first mode and first and second type data are superimposed in a second mode, and the position in

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which the first type data is superimposed in the first mode differs from the position in which the first type data is superimposed in the second mode.

In re pages 8-9, applicants argue that, under the Examiner's interpretation of the patent, the patent fails to teach or suggest a device in which, depending on the display mode, the position at which character information is displayed is varied, even when the character information is not changed.

In response, the examiner respectfully disagrees. As discussed above, the position on which the first type data (DATA1 in mode "01") is superimposed in the first mode (mode "01") differs from the position in which the first type data (DATA1 in mode "11") is superimposed in the second mode (mode "11") because the amount of data in two modes are different and even when the character information in DATA1 and DATA2 is not changed. Thus, Shimada et al discloses the claimed device in which, depending on the display mode, the position at which character information is displayed is varied, even when the character information is not changed.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 49-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 5,719,984 in view of Shimada et al ('772) as set forth in paragraph #3 of the Final Office Action mailed April 09, 2003.

Regarding claim 49 of this application, claim 1 of U.S. Patent No. 5,719,984 cites all the claimed limitations except for providing means for superimposing the image information and the ID information read out from the recording medium; wherein said superimposing means has a first mode in which first type data contained in the ID data is superimposed with the image information, and a second mode in which the first type data and second type data contained in the ID data are both superimposed with the image information; and wherein the position at which the first type data is superimposed on a display screen of said display device in said first mode and the position at which the first type data is superimposed on the display screen in the second mode different from each other.

Shimada et al teaches an apparatus for recording additional video signal having means (col. 4, lines 1-21 and col. 5, lines 16-63) for superimposing the image information read out from the recording medium with the ID information read out from the recording medium; wherein said superimposing means has a first mode in which data of a first type contained in the ID data is superimposed with the image information, and a second mode in which the data of the first type and data of a second type

contained in the ID data are both superimposed with the image information (col. 4, lines 1-21 and col. 5, lines 16-63); and wherein the position at which the data of the first type is superimposed on a display screen in said first mode and the position at which the data of the first type is superimposed on a display screen in the second mode different from each other (col. 4, lines 1-21 and col. 5, lines 16-63) so that the superimposing characters and so forth in a recording mode can be simplified (col. 1, lines 42-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide claim 1 of U.S. Patent No. 5,719,984 with the capability of superimposing characters on the video signal reproduced from the recording medium as taught by Shimada et al in order to simplify superimposing characters on the video signal in recording and reproducing modes.

Regarding claim 50 of this application, claim 2 of U.S. Patent No. 5,719,984 cites wherein the data of the first type is date information.

Regarding claim 51 of this application, claim 1 of U.S. Patent No. 5,719,984 cites all the claimed limitations except for providing reading means for reading the information signal and ID information of the information signal from the recording medium; conversion for converting the ID information read out by the reading means into a character information; setting means for setting a display mode for displaying the character information converted by the conversion means on the display device; superimposing means for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means for

changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed.

Shimada et al teaches an apparatus for recording additional video signal having reading means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading the information signal and ID information of the information signal from the recording medium; conversion means (14 of Fig. 1, col. 4, lines 34-40) for converting the ID information read out from the reading means into a character information; setting means (15 of Fig. 1, col. 5, lines 29-45) for setting a display mode of the character information converted by the conversion means on the display device; superimposing means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means (15 and 18 of Fig. 1, col. 5, lines 29-63) for changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed (col. 5, lines 16-63) so that the superimposing characters and so forth in a recording mode can be simplified (col. 1, lines 42-52).

It would have been obvious to one of ordinary skill in the art at the time of the



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invention to provide claim 1 of U.S. Patent No. 5,719,984 with the capability of superimposing characters on the video signal reproduced from the recording medium as taught by Shimada et al in order to simplify superimposing characters on the video signal in recording and reproducing modes.

Regarding claim 52, Shimada et al also discloses the claimed wherein the claimed setting means sets the display mode according to a number of items contained in the ID information (col. 4, lines 1-21 and col. 5, lines 29-63).

Regarding claim 53, the combination of claim 1 of U.S. Patent No. 5,719,984 and Shimada et al discloses all the features of the instant invention except for providing that the information signal recording in the recording medium is an image taken by an electronic camera and the ID information includes a date of image-taking.

The capability of using the electronic camera to recording an image and the date of image-taking is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the tie of the invention to incorporate the well known electronic camera into claim 1 of U.S. Patent No. 5,719,984 in order to record desired images.

The method claim 54 is rejected for the same reasons as discussed in the apparatus claim 49 above.

The method claim 55 is rejected for the same reasons as discussed in the apparatus claim 51 above.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 49, 51-52 and 54-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimada et al ('772) as set forth in paragraph #5 of the Final Office Action mailed April 09, 2003.

Regarding claim 49, Shimada et al discloses a reproducing apparatus (Fig. 1) for reading out image information and ID data of the image information recorded with the image information from a recording medium to output the information and the ID data to a display device having means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading out the image information; means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the image information and the ID data read out from the recording medium; and output means (28 of Fig. 1, col. 5, lines 48-54) for outputting the image information and the ID data superimposed by the superimposing means to the display device; wherein said superimposing means has a first mode in which first type data contained in the ID data is superimposed with the image information, and a second mode in which the first type data and second type data contained in the ID data are both superimposed with the image information (col. 4, lines 1-21 and col. 5, lines 16-63); and wherein the position at which the first type data is superimposed on a display screen of said display device in said first mode and the position at which the first type data is superimposed on the display screen in the second mode different from each other (col. 4, lines 1-21 and col. 5, lines

16-63).

Regarding claim 51, Shimada discloses a reproducing apparatus (Fig. 1) for reading out information signal from a recording medium to output the signal to a display device having reading means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading the information signal and ID information of the information signal from the recording medium; conversion means (14 of Fig. 1, col. 4, lines 34-40) for converting the ID information read out by the reading means into a character information; setting means (15 of Fig. 1, col. 5, lines 29-45) for setting a display mode for displaying the character information converted by the conversion means on the display device; superimposing means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means (15 and 18 of Fig. 1, col. 5, lines 29-63) for changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed (col. 5, lines 16-63).

Regarding claim 52, Shimada et al also discloses the claimed wherein the setting means sets the display mode according to a number of items contained in the ID information (col. 4, lines 1-21 and col. 5, lines 29-63).

The method claim 54 is rejected for the same reasons as discussed in the apparatus claim 49 above.

The method claim 55 is rejected for the same reasons as discussed in the apparatus claim 51 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 50 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada et al ('772) as set forth in paragraph #7 of the Final Office Action mailed April 09, 2003.

Regarding claim 50, Shimada et al discloses all the features of the instant invention (see the rejection of claim 49 above) except for providing that the common item is a date information.

Shimada et al teaches in col. 6, lines 3-9 that "according to the present invention,

as described hereinabove, it becomes possible to additionally insert any of titles, subtitles, superimposed time indications, superimposed commercials, superimposed dialogues and still pictures by the technique of after-recording in a track region Sp formed for coded audio signal".

It would have been obvious to one of ordinary skill in the art at the time of the invention to record the date information in a track region Sp formed for coded audio signal since it merely amounts to selecting characters information.

Regarding claim 53, Shimada et al discloses all the features of the instant Invention (see the rejection of claim 51 above) except for providing that the information signal recording in the recording medium is an image taken by an electronic camera and the ID information includes a date of image-taking.

The capability of using the electronic camera to recording an image and the date of image-taking is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known electronic camera into Shimada et al's system in order to record desired images.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

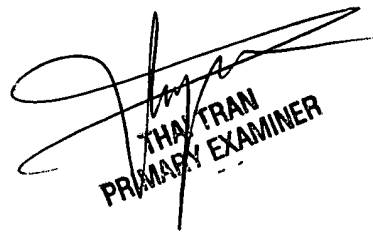
The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TTQ



THUY TRAN  
PRIMARY EXAMINER